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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,986	12/05/2003	Paul Gilson	A9020	7246

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Sughrue Mion-ABBOTT LABS
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EXAMINER	
GRAY, PHILLIP A	

ART UNIT	PAPER NUMBER
3767	

NOTIFICATION DATE	DELIVERY MODE
07/21/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/727,986	GILSON ET AL.	
	Examiner	Art Unit	
	Phillip Gray	3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-61* is/are pending in the application.

4a) Of the above claim(s) *43-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-42 and 59-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response Applicant's communication of 1/6/2010. Currently amended claims 29-42, 59-61 are pending and rejected below.

Response to Arguments

Applicant's arguments, see remarks, filed 1/6/2010, with respect to the 112 rejection concerning claims 59 and 60 and the "pod"/"tubular member have been fully considered and are persuasive. The 112 rejection of claims 59-60 has been withdrawn.

Applicant's arguments filed 1/6/2010 with respect to the 112 rejection of claim 29 have been fully considered but they are not persuasive. Applicant points out that an "embolic protection filter" is and "intravascular embolic filter device" (as in applicant's specification), is an "intravascular filter being placed distally to capture procedural emboli" (again applicant's specification), "structure and design" as in applicant's figure 7, and "*is simply different from the implant of Dwyer*". Examiner is still unsure if the claim limitation "embolic protection filter" is simply a mesh or filter material which separates emboli, or constitutes more (or less) structure then that. Applicant's remarks failed to remedy this question.

Concerning the arguments directed to the 103 rejection, it is further examiners position that Dwyer and the combination of the prior art would disclose the "outer diameter of the catheter tubular body is substantially constant from the proximal to distal portion", Examiner is of the opinion that this is shown in figure 3 elements 34 to

elements 32 and 22 and 18 for examples. Therefore examiner is maintaining the 103 Dwyer in view of Daniel rejection. See below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 31, 34, 39-42, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer (U.S. Patent Number 6,395,017) in view of Daniel et al. (U.S. Patent 6,001,118).

Dwyer discloses a catheter device (Figure 3-5) for the deployment of a medical device, with an polymeric elongate tubular body (elements 34 to elements 32 of figure 3

specifically 22 and 18), with an embracing pod (23) located at the distal end (30 as one example) of the catheter tubular body for reception of the medical device and with sufficient axial rigidity, a deployer (28 or 4) movable through the pod. Further Dwyer comprises a funnel shaped bored loading device (figure 6 element 44), with a thin walled loading tube (4) projecting from a main support (44). It is examiners position that the thin walled distal portion of the catheter tubular body is of reduced wall thickness relative to a proximal portion of the catheter tubular body (elements from 20 thick section to thin or reduced section 22) and the pod has a greater flexibility then the proximal portion of the tubular body (20).

Further in Dwyer the "outer diameter of the catheter tubular body is substantially constant from the proximal to distal portion", note figure 3 elements 34 to elements 32 and 22 and 18.

All the elements of Dwyer are fully capable of satisfying all structural, spatial, functional, and operational limitations of the claims as written. Concerning the claim language of the "deployer" movable "in a proximal to distal direction through the pod", examiner draws applicant's attention to figures 10a, 10b, and 10c and note the deployer moves and is movable in a proximal to distal direction through the pod (note deployer (unnumbered but attached to element 16 moves in a distal direction through the pod near element 22).

Dwyer discloses the claimed invention except for the medical device is an embolic protection filter. Daniel teaches that it is known to use a medical device of an embolic protection filter as set forth in paragraphs at columns 1-3 and 9-12 to provide a

means to deal with fragments of the stenosis during a medical procedure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Dwyer with an embolic protection filter as taught by Daniel, since such a modification would provide the system with an embolic protection filter for providing a means to deal with fragments of the stenosis during a medical procedure.

In regards to claim 31, Dwyer discloses the claimed invention except for the tubular body tapers distally at a location proximal and adjacent the pod. It would have been an obvious matter of design choice to for the tubular body tapers distally at a location proximal and adjacent the pod, since it is well known in the catheter arts for wall thickness and structure to taper to enhance flexibility, support, and define a lumen.

In regards to claim 34, Dwyer discloses the claimed invention except for a wall thickness of less than or equal to 0.004 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall thickness of less than or equal to 0.004 inches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)*.

In regards to claims 39-40, Dwyer discloses the claimed invention except is silent as to the cone angles of the bore between 15 and 65 degrees or 35 and 45 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct a cone with angles of the bore between 15 and 65 degrees or 35

and 45 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller, 105 USPQ 233 (CCPA 1955).*

In regards to claim 41-42, Dwyer discloses the claimed invention except is silent as to the main support being made from Perspex or a metal spigot, and the loading tube from polytetrafluoroethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the main support from Perspex or a metal spigot, and the loading tube made from polytetrafluoroethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).*

Concerning claims 59-60 and "the thin-walled distal portion of the catheter tubular body of reduced wall thickness relative to a proximal portion of the catheter tubular body" see figure 6 near 25.

Concerning claim 61, it is examiner's position that the Dwyer would be of sufficient axial rigidity to allow for retraction of the medical device directly into the pod as evidenced in Dwyer at paragraphs at column 10 lines 25-67.

Claim Rejections - 35 USC § 112 (2nd time)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear from the claim whether the "embolic protection filter carries more elements then simply a mesh. If so then the "implant assembly" of Dwyer would satisfy this claim limitation. Further the claim is incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. What does an "embolic protection filter" in tale, or is it simply a tubular membrane? Appropriate correction is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571)272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phillip Gray/
Examiner, Art Unit 3767

/KEVIN C. SIRMONS/
Supervisory Patent Examiner, Art Unit 3767